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| APPLICATION NO.                      | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO.     | CONFIRMATION NO. |
|--------------------------------------|-------------|----------------------|-------------------------|------------------|
| 10/747,808                           | 12/30/2003  | Herve Mongin         | 1013-032                | 1846             |
| 22429                                | 7590        | 09/01/2005           | EXAMINER                |                  |
| LOWE HAUPTMAN GILMAN AND BERNER, LLP |             |                      | NGO, HUNG V             |                  |
| 1700 DIAGONAL ROAD                   |             |                      | ART UNIT                | PAPER NUMBER     |
| SUITE 300 /310                       |             |                      | 2831                    |                  |
| ALEXANDRIA, VA 22314                 |             |                      | DATE MAILED: 09/01/2005 |                  |

Please find below and/or attached an Office communication concerning this application or proceeding.

|                              |                        |                     |
|------------------------------|------------------------|---------------------|
| <b>Office Action Summary</b> | <b>Application No.</b> | <b>Applicant(s)</b> |
|                              | 10/747,808             | MONGIN ET AL.       |
|                              | <b>Examiner</b>        | <b>Art Unit</b>     |
|                              | Hung V. Ngo            | 2831                |

*-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --*

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

1)  Responsive to communication(s) filed on 21 March 2005.

2a)  This action is **FINAL**.                            2b)  This action is non-final.

3)  Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## **Disposition of Claims**

4)  Claim(s) 1-20 is/are pending in the application.  
4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

5)  Claim(s) 11-13 and 15 is/are allowed.

6)  Claim(s) 1-5 and 16-20 is/are rejected.

7)  Claim(s) 6-10 and 14 is/are objected to.

8)  Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

9)  The specification is objected to by the Examiner.

10)  The drawing(s) filed on \_\_\_\_\_ is/are: a)  accepted or b)  objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)  The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

12)  Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a)  All    b)  Some \* c)  None of:  
1.  Certified copies of the priority documents have been received.  
2.  Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3.  Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

1)  Notice of References Cited (PTO-892)  
2)  Notice of Draftsperson's Patent Drawing Review (PTO-948)  
3)  Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_

4)  Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_  
5)  Notice of Informal Patent Application (PTO-152)  
6)  Other: \_\_\_\_\_

## DETAILED ACTION

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 14, 16-20 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 16, line 9, "communication device for enabling the adapting element to receive personalization data from a personalization device". The communication device does not include a personalization device. However, claims 20, line 2, recites the personalization machine includes a cylinder, wheel or linear elevator. This confuses the scope of the claims.

Claim 17, line 1, "the driving system" lacks antecedent basis.

Claim 18, line 1, "the driving system" lacks antecedent basis.

Claim 19, line 1, "the insertion and/or removal systems" lacks antecedent basis.

Claims 14, 19, lines 2-4, "and/or" are confusing.

Claims 17-20 are not considered over prior art because of 35 USC 112 problems.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 2, 16 are rejected under 35 U.S.C. 102(b) as being anticipated by Harari et al. (US 6,381 ,662).

Regarding claim 1, Harari et al. discloses in Fig. 1 an adapting element 10 for at least one programmable electronic holder 20 to be personalized, having a surface size larger than that of all programmable electronic holders 20 to be personalized (see Fig. 5A) and meeting the size accepted by a personalization machine 200, the adapting element 10 being characterized in that it is provided with a housing of adapted shape and size to house and maintain at least one programmable electronic holder, and in that it comprises first communication means 12,212 enabling it to receive personalization data, via contact or contactless link, from a personalization device of a personalization machine, and second communication means 14,24 enabling it to transmit said personalization data to the programmable electronic holder 24 via contact or contactless link and capable of functioning as claimed.

Regarding claim 2. The adapting element according to claim wherein the second communication means are at least one holder connector 24, able to maintain at least one programmable electronic holder 20, and electric or optical links, ensuring the link between the holder connector and the first communication means 12 of the adapting element 10.

#### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 3-5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Harari et al in view of Fehrman et al (US 6,193,163).

Regarding claims 3-5, Harari et al. do not disclose that the communication means are contactless links via an antenna. However, Fehrman et al. teaches an adapting element in Fig. 9 wherein the communication means is a contactless link via an antenna (col. 1, lines 25-28). It would have been obvious to one having ordinary skill in the art at the time the invention was made to have the communication means in the form of a contactless link via an antenna as taught by Fehrman et al. so that data may be transferred without having to make direct electrical contact with the adapting element, electronic holder, and personalization machine.

#### ***Allowable Subject Matter***

Claims 11-13, 15 are allowed

Claim 14 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

Claims 6-10 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitation of the base claim and any intervening claims.

The following is a statement of reasons for the indication of allowable subject matter

the prior art alone or in combination does not teach or fairly suggest a use of a plurality of identical adapting elements in a personalization machine, the personalization machine comprising an unstacking system to unstack adapting elements and a stacking system to stacking adapting elements, an insertion system to insert electronic holders in the adapting elements and a removal system to remove electronic holders in the adapting elements, a driving system to drive the adapting elements through the personalization machine, and a communication system between a database and the electronic holders, taken in combination with the other claimed features.

***Response to Arguments***

Applicant's arguments filed 03-21-05 have been fully considered but they are not persuasive.

Applicant argues (1) that Harari et al do not disclose the adapting element is adapted for use with a personalization machine and can be adapted to a range of programmable electronic holders. With respect to (1), a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 370 F.2d

576, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 312 F.2d 937, 939, 136 USPQ 458, 459 (CCPA 1963).

***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hung V. Ngo whose telephone number is (571) 272-1979. The examiner can normally be reached on Monday to Thursday 8:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Dean A. Reichard can be reached on (571) 272-2800 EXT 31. The fax

phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

HVN  
08-28-05

Hung V Ngo

**HUNG V. NGO  
PRIMARY EXAMINER**